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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/822,663

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Katsuaki Takahashi

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07/29/2008

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.

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SUITE 370

ALEXANDRIA, VA 22314

EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/822,663	<b>Applicant(s)</b> TAKAHASHI ET AL.	
	<b>Examiner</b> P. Kathryn Wright	<b>Art Unit</b> 1797	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 20-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 17, 2008 has been entered.

### ***Status of the Claims***

2. This action is in response to papers filed June 17, 2008 in which claims 13-19 were canceled and claims 20-26 were added. The amendments have been thoroughly reviewed and entered.

The previous rejections in the Office Action dated June 19, 2007 are withdrawn in view of the amendments. Applicant's arguments have been thoroughly reviewed but are deemed moot in view of the amendments, withdrawn rejections, and new grounds for rejection. New grounds for rejection, necessitated by the amendments, are discussed. Any objection/ rejection not repeated herein has been withdrawn by the Examiner.

Claims 12 and 20-26 are under prosecution.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 12 and 20-26 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The measuring mechanism is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claims are directed to an automatic analyzer, however no element is claimed to enable the device to function as such. The measuring unit disclosed in the specification is not claimed as an element of the device, as such it unclear how the sample dispensing mechanism, sample container disk, information reader, and controller can function as an automated analyzer.

Also, an information storing section for storing preliminary sample information is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The claims now recite a controller for, *inter alia*, checking whether the sample information identified by the sample information reader corresponds to the sample information stored in a information storing section (see page 5, last line to page 7 first full paragraph). However no information storing section is claimed to enable the controller to perform the checking operation.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12 and 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As discussed previously, claim 12 now recites a controller for, *inter alia*, checking whether or not a sample to be suck or already sucked by the sample dispensing mechanism is a sample whose information has been previously read by the information reader immediately before checking by the controller. This recitation is confusing and indefinite. How can the controller check sample information immediately before checking by the controller? This limitation appears to be circular and lacks clarity. Furthermore, beginning at page 5, the specification describes a controller that checks whether the sample information identified by the sample information reader corresponds to the sample information stored in an information storing section. However, no sample information storing section is recited in the claim. Clarification is required.

Similarly, claim 21 recites "the controller issues an alarm when a sample that has been dispensed is different from the sample identified". However, page 7, first paragraph, of the specification describes "[w]hen the information on the sample read at the second time and the information on the sample that is read at the first time and stored in advance are different from each other, a function of issuing an alarm to the operator of the apparatus...may be additionally provided." Thus, a sample information

storing section is necessary to determine whether the stored sample information is different from the sample information read a second time so as to sound an alarm.

Claim 23 recites "the cover comprises a portion covering at least one part of a moving locus of the front end of a probe of the sample dispensing mechanism." It is not clear what Applicant means by the phrase "one part of a moving locus of the front end of a probe". The specification, at page 16, lines 1-4, describes a sample hand-contact preventing plate having longitudinal walls and the front end of the sample probe remains hidden in the longitudinal walls on it moving locus. Is Applicant trying to claim the longitudinal walls of the cover plate?

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 12, 20-22, and 24-25, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent no. 5,827,479 to Yamazaki et al., hereinafter "Yamazaki".

Yamazaki teaches an automatic analyzer system as currently claimed. Yamazaki teaches a container 33 for holding a liquid and liquid dispensing mechanisms 5a,5b for dispensing liquid into the container.

The analyzer system of Yamazaki includes a container disk (i.e., carousel 4, 4a, 4b) arranged to accommodate the plurality of containers 33 arranged circularly on the disk, and to transfer the containers 33 to the dispensing position of the dispensing mechanism (Figs. 1; and col. 4, lines 46 et seq.)

Yamazaki teaches a controller 17 for controlling the dispensing mechanisms 5a, 5b and container disk. The Yamazaki controller identifies the liquid in the container 33 on the basis of the information in the information recording mediums 20, 21 (i.e., bar code, IC chip) attached to the containers 33 and read by information reader 7 (see col. 3, lines 53-57). The Yamazaki controller also checks whether the information identified by the information reader 7 corresponds to the information stored in an information storing section 18 (see col. 4, line 50 et seq). That is, Yamazaki teaches the information on the container is read by the information reader 7 prior to and after dispensing, and optionally read every time the bottle is removed (see for example col. 6, lines 32-65).

Please note that while the fluid containers of Yamazaki are used to dispense reagent rather than sample as claimed, a recitation with respect to the manner in which a claimed apparatus is intended to be employed fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.

As to claim 20, the controller 17 of Yamazaki controls the dispensing mechanism to suck a liquid from the container when the liquid to be sucked is the same liquid

whose information has been already read by information reader 7 (see for example col. 6, lines 32-65).

With respect to claim 21, Yamazaki teaches an alarm means that displayed on the operating unit when the amount of fluid is “different from “ from the sample identified, i.e., depleted (see col. 6, lines 16 et seq.)

Regarding claim 22, Yamazaki teaches a cover (lid 11) capable of preventing the container from being taken out of the transfer mechanism until after the dispensing mechanism dispenses the liquid from the container (see col. 4, lines 20-31 and col. 6, lines 32-56). As discussed above, the method or process of using the above described analyzer is not determinative of the metes and bounds of an apparatus claim. Such limitations are merely an intended use which the prior art would inherently be capable of doing.

As to claim 24, the cover 11 of Yamazaki further comprises a mechanism for moving (i.e., motor 13) from a position covering the container disk so that a container 33 on the sample container disk can be taken out via opening 10(see fig. 2).

Regarding claim 25, Yamazaki teaches movement detectors 14 and 15 for detecting the movement of the cover. The controller of Yamazaki controls dispensing mechanism so as not to dispense a liquid when the movement detector detects the movement of the cover (see col. 4, lines 20-col. 6, line 31).



***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki (US Patent No. 5,827,479) in view of Ishizawa (US Patent no. 6,413,475)

The teachings of Yamazaki have been summarized previously, supra. Yamazaki does teach a cover 11, however, Yamazaki does not explicitly teach the cover having longitudinal walls along the probe moving locus (claim 23) or the cover being made from an electrically conductive material (claim 26).

Ishizawa teaches an analyzer system having a guard 13 used to prevent a foreign article from approaching the probe during an operation of the sample pipetting probe 105, and especially, to prevent a hand of the operator from contacting the

pipetting probe. The guard 13 may be constituted of metal (i.e., electrically conductive material). The guard department 13 longitudinal walls 14 along the probe moving locus (i.e., up and down). The conductive material of the guard 13 and walls 14 acts as liquid level detecting means designed to reduce the dipping depth of the pipetting probe as much as possible, which in turn, reduces the quantity of the sample liquid adhered to an outer wall of the probe and the likelihood of the cross-contamination between liquid containers (see background of invention section of Ishizawa).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the analyzer system of Yamazaki, the electrically conductive plate of Ishizawa, in order to reduce the quantity of the sample liquid adhered to an outer wall of the probe which, in turn, reduces the likelihood of the contamination (see the background of invention section of Ishizawa).

### ***Conclusion***

12. No claims allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is (571)272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. Kathryn Wright/

Patent Examiner, Art Unit 1797

pkw